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Atty Dkt No. GP-303804 (GM-0446PUS)

Remarks

This Amendment is intended to be fully responsive to the Office Action mailed March 22, 2005. In the Action mailed March 22, 2005, the Examiner rejected claims 1-18 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner stated that claims 1-7 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, stated above. The Examiner rejected claims 8, 10 and 12-18 under 35 U.S.C. §102b as being anticipated by French Publication FR 2706011A1. The Examiner rejected claims 8, 12-14 and 16-18 under 35 U.S.C. §102b as being anticipated by Miller, U.S Patent No. 3,941,013.

In this Amendment, Applicants have amended claims 1, 8 and 11-15.

Rejections Under 35 U.S.C. §112(2)

Claims 1-18 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner stated:

Claim 1, lines 23-35 and claims 11-15 recite limitations for torque mechanisms to selectively interconnect two members located on opposite sides of the mechanisms. However, the claims are not specific about which members are on the two opposite sides. Instead, the claims recite alternatives (at least two) for at least one side of the mechanisms.

Accordingly, claims 1 and 11-15 have been amended, without prejudice, to limit alternative members that may be interconnected by the torque-transmitting mechanisms. Claim 1 has been amended to recite the limitation "said pair of members interconnected by said third torque transmitting mechanism being different from said pair of members interconnected by said first torque-transmitting mechanism..." Claim 1 has also been amended to recite the limitation "said pair of members interconnected by said seventh torque-transmitting mechanism being

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different from said pair of members interconnected by said first, third, fourth or fifth torque-transmitting mechanisms..." Furthermore, claim 1 has been narrowed to remove the reference to the "second" planetary gear set in the selective interconnections for the third through the seventh (inclusive) torque-transmitting mechanisms.

Claim 11 has been amended to include the limitation "said pair of members interconnected by said third torque-transmitting mechanism being different from said pair of members interconnected by said first torque-transmitting mechanism..." Claim 13 has been amended to include the limitation "said member interconnected by said fifth torque-transmitting mechanism being different from said member interconnected by said fourth torque-transmitting mechanism..." Claim 15 has been amended to include the limitation "said pair of members interconnected by said seventh torque-transmitting mechanism being different from said pair of members interconnected by said first, third, fourth or fifth torque-transmitting mechanism..." Further, claims 11-15 have been narrowed to remove the reference to the "second" planetary gear set in the selective interconnections for the third through the seventh (inclusive) torque-transmitting mechanisms.

Accordingly, Applicants' respectfully submit that the rejections for indefiniteness under 35 U.S.C. §112, second paragraph have been overcome with respect to claims 1-18.

#### Rejections Under 35 U.S.C. §102b – Pierre

The Examiner rejected claims 8, 10 and 12-18 under 35 U.S.C. §102b as being anticipated by French Publication FR 2706011A1, published in December 1994 for Tosi Pierre ("Pierre"). For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

Applicants' respectfully submit that claims 8, 10 and 12-18 are not anticipated by Pierre. First, with respect to Figure 1 of Pierre, amended claim 8 requires that there be only

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three interconnecting members continuously connecting the members of the gear sets. Claim 8 has been amended to recite the limitation "the transmission includes only said first, second and third interconnecting members continuously connecting said members of said gear sets." (emphasis added). Figure 1 of Pierre discloses five fixed interconnections (56-54, 52-44, 34-40, 28-30, 26-28) and thus does not contain all the limitations of amended claim 8.

Second, with respect to Figures 2 and 3 of Pierre, Pierre discloses different fixed interconnections from the fixed interconnections recited by Applicants in claim 8.

Applicants' claim 8 recites:

a first interconnecting member continuously interconnecting said first member of said first planetary gear set with said first member of said second planetary gear set; a second interconnecting member continuously interconnecting said second member of said first planetary gear set with said second member of said second planetary gear set; a third interconnecting member continuously interconnecting said third member of said second planetary gear set with said first member of said third planetary gear set" (emphasis added).

The fixed interconnections disclosed by Pierre are from the first member of first planetary gear set to the first member of the second planetary gear set (either 34 to 40 or 30 to 28 or vice-versa, see Fig. 2), from the second member of the first planetary gear set to the second member of the second planetary gear set (either 30 to 28 or 34 to 40 or vice versa, see Fig. 2), and from the second member of the second planetary gear set to the first member of the third planetary gear set (must be 28 to 26 or vice versa).

Thus Applicants' third interconnecting member continuously interconnects the third member of the second planetary gear set with the first member of the third planetary gear set, whereas in Pierre's disclosure, the second member of the second planetary gear set is connected to the first member of the third planetary gear. Thus, amended claim 8 does not read upon the structure shown in Figures 2 and 3 of Pierre.

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Finally, with respect to Figures 2 and 3 of Pierre, Applicants' claim 8 recites that the torque-transmitting mechanisms are engaged "in combinations of two to establish at least eight forward speed ratios and at least one reverse speed ratio..." (emphasis added). The disclosure in Pierre's Figures 2 and 3 could not possibly provide the eight speed ratios required by amended claim 8. Pierre's Figures 2 and 3 provide only three clutches/brakes, thus they can provide at most three speed ratios for the three clutches/brakes, engaged in combinations of two.

Thus the disclosures in Pierre do not contain all the limitations recited in amended claim 8. Thus Pierre does not anticipate claim 8 or claims 10 and 12-18, which depend from claim 8. Accordingly, the rejections of claims 8, 10, 12-18 under Pierre are believed to be overcome.

#### Rejections Under 35 U.S.C. §102b – Miller

The Examiner rejected claims 8, 12-14 and 16-18 under 35 U.S.C. §102b as being anticipated by U.S. Patent No. 3,941,013, issued to Miller ("Miller"). For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

Applicants' respectfully submit that amended claim 8 is not anticipated by Miller. First, amended claim 8 requires that there be only three interconnecting members continuously connecting the members of the gear sets. More specifically, claim 8 has been amended to recite the limitation "the transmission includes only said first, second and third interconnecting members continuously connecting said members of said gear sets." (emphasis added).

Figure 1 of Miller discloses five fixed interconnections and thus does not contain all the limitations of amended claim 8. Figure 4 of Miller discloses only two fixed interconnections. Figure 5 of Miller discloses only two fixed interconnections. Figure 6 of Miller

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discloses five fixed interconnections. Furthermore, Applicants' claim 8 requires that at least eight forward speed ratios and at least one reverse speed ratio is provided. The disclosure in Miller's Figure 4 provides for only six speeds (see Table II), while Figure 5 of Miller provides for only seven speeds (see Table III).

Thus the disclosures in Miller do not contain all the limitations recited in amended claim 8. Thus Miller does not anticipate claim 8 or claims 12-14 and 16-18, which depend from claim 8. Accordingly, the rejections of claims 8, 12-14 and 16-18 under Miller are believed to be overcome.

It is therefore respectfully submitted that all claims are in condition for allowance, which action is requested.

Respectfully submitted,

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